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9-30-03

HEWLETT-PACKARD COMPANY
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Docket No.: 10004909-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John M. Baron

Application No.: 09/765,172

Confirmation No.: 7463

Filed: January 18, 2001

Art Unit: 2674

For: A SYSTEM FOR A NAVIGABLE DISPLAY

Examiner: J. Nguyen

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Technology Center 2600

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on June 12, 2003.

The fees required under § 1.17(f) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments

- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
- IX. Claims Involved in the Appeal
- Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Company, a California corporation, having its principal place of business in Palo Alto, California.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 20 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None.
2. Claims withdrawn from consideration but not canceled: 18 – 20.
3. Claims pending: 1 – 20.
4. Claims allowed: None.
5. Claims rejected: 1 – 20.

C. Claims On Appeal

The claims on appeal are claims 1 – 17.

IV. STATUS OF AMENDMENTS

Applicant filed an Amendment After Final Rejection on May 12, 2003. The Examiner responded to the Amendment After Final Rejection in an Advisory Action mailed May 29, 2003. No amendments were submitted in Applicant's May 12, 2003 response. Concurrently with this Appeal Brief, Applicant filed a Supplemental Amendment After Final Rejection request the cancellation of claims 18 – 20. Because this Amendment is filed concurrently herewith, the Examiner has taken no action.

Accordingly, the claims enclosed herein as Appendix A incorporate the proposed cancellation of claims 18 – 20, as indicated in the Supplemental Amendment filed.

V. SUMMARY OF INVENTION

The invention provides a switch platform (104) for allowing a user to interact with a display (103). Spec. p. 9, lns 1 – 4. To operate the system, the user presses the display (103) or display frame/platform (104) to actuate the switches (200, 201, 202, 203, 204) positioned under the platform (104). Spec. p. 13, lns 1 – 20. Depending on the direction that the user presses, a specific one or ones of the switches (200 – 204) are activated sending signals to the system processor (800). Spec. p. 13, lns 23 – 28. Thus, by depressing the switch platform (104)/display (103) assembly, the user may interact with the operation of the camera (100) or other item configured with the invention. Spec. p. 13, ln 23 – p. 14, ln 5.

VI. ISSUES

A. First Issue

1. Whether the switch platform mounted to detect a touching about a periphery of the display of claims 1 – 20 is anticipated or rendered obvious by *Brisebois*' edge user interface element which is separate but, at most, adjacently touching its disclosed display alone or in combination with *Goto*.

B. Second Issue

1. Whether *Brisebois* and *Goto* have been properly combined by the Examiner in alleging a rejection under 35 U.S.C. § 103.

VII. GROUPING OF CLAIMS

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

Group Claim(s)

I. Claims 1 – 17

In Section VIII below, Applicant has included arguments supporting the patentability of group I as required by M.P.E.P. § 1206.

VIII. ARGUMENTS

A. First Issue

1. *Whether the switch platform mounted to detect a touching about a periphery of the display of claims 1 – 20 is anticipated or rendered obvious by Brisebois' edge user interface element, which is separate but, at most, adjacently touching its disclosed display, alone or in combination with Goto.*

The Examiner has rejected claims 1, 2, 5, 6, 8, and 10 – 12 under 35 U.S.C. § 102(e) in view of *Brisebois* (U.S. Patent No. 6,369,803), and has rejected claims 3, 4, 7, 9, and 13 – 17 under 35 U.S.C. § 103(a) in view of *Brisebois* or *Brisebois* and *Goto* (U.S. Patent No. 5,862,419). Appellant urges that the Examiner's rejections fail because *Brisebois* does not teach each and every limitation of the claimed invention either singly or in combination with *Goto*.

Brisebois teaches that “[a]ctive edge input device 120 is a user interface device positioned adjacent [to] display 110. Active edge input device 120 may actually touch display 110 or lay a predetermined distance away from an edge of display 110.” Col. 3, lns 48 – 51. The Examiner has concluded, based on this statement, that *Brisebois* teaches that it is desirable to locate the touch display overlapping onto the display. However, neither the Examiner's cited selections nor the other disclosure from *Brisebois* teaches that the active edge input device may be located on the display, only that, in its position adjacent to the display, it may actually touch the display. Nowhere in *Brisebois* is there any teaching that

the flexible input device is desired to be positionable on the display. Appellant believes that the Examiner's conclusion is not consistent with the teachings of *Brisebois*.

In support of her conclusion, the Examiner cited to column 5, line 49 to column 6, line 10 as purportedly describing additional embodiments of *Brisebois* that required touching the actual display. The material cited by the Examiner discusses Figures 2b and 2c of *Brisebois*. However, Figures 2b and 2c describe a detailed view of the active edge input device and not the display. Neither the locations cited by the Examiner, nor any other discussion in *Brisebois*, teach or suggest that one possible embodiment requires the user to touch the actual display. Therefore, the teachings of *Brisebois* do not support the Examiner's conclusion that it suggests any embodiments where touching the actual display is required.

2. Conclusion

Based on the foregoing, Appellant respectfully submits that claims 1 – 17 are patentable under 35 U.S.C. § 102(e). Reversal of the rejections is courteously solicited.

B. Second Issue

1. Whether *Brisebois* and *Goto* have been properly combined by the Examiner in alleging a rejection under 35 U.S.C. § 103.

The motivation for making the combination was presented as follows:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the electronic control system as taught by *Brisebois* in the system of *Goto* in order to support interactive communication between a user and a user environment.

Goto discloses that the user must touch the display in order to designate the principal object to be photographed. Col. 6, lns 55 – 66. That operation enables the principal object of the invention. However, *Brisebois* defines a touch-activated user input device located near the perimeter or adjacent to the display of the device. Col. 2, lns 7 – 29. The user input device is not located on the display because *Brisebois* teaches that "it is desirable to provide an improved user interface device that is robust and ergonomically correct to create a user-friendly environment that does not require... touching the actual display". Col. 2, lns 1 – 4.

(emphasis added) *Brisebois* discusses that requiring the user to touch the actual display provides a less desirable interface because the user's hand may block the view of the screen and/or the screen typically and quickly becomes dirty. Col. 1, lns 55 – 67. Thus, *Goto*'s teaching of directly touching the display teaches away from *Brisebois*' teaching of a system to avoid directly touching the display. Therefore, the rejection of claims 1 – 17 should be withdrawn.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. However, as discussed above, not only does *Goto* fail to suggest the combination with *Brisebois*, but actually teaches away from the invention disclosed in *Brisebois*. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

IX. CLAIMS INVOLVED IN THE APPEAL

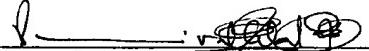
A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant concurrently with this Appeal Brief.

Applicant has enclosed all fees believed due with this response. However, if additional fees are due or there is an overpayment, please use Deposit Account No. 08-2025, under Order No. 10004909-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256035023US, in an envelope addressed to: MS Appeal Brief-Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

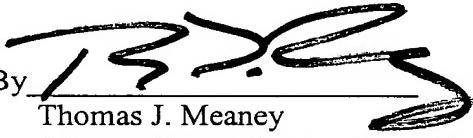
Date of Deposit: September 8, 2003

Typed Name: John Pallivathukal

Signature: 

Respectfully submitted,

By


Thomas J. Meaney
Attorney/Agent for Applicant(s)
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Date: September 8, 2003

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/765,172

1. (Original) A display for use in controlling the execution of a functional device, said display comprising;
an electronic control system housed in association with said display, said electronic control system including a switch platform mounted to detect a touching about a periphery of said display and to provide a plurality of discrete output signals each indicative of a portion of said periphery at which said touching is detected.
2. (Original) The display of claim 1 wherein said display is a flat panel display.
3. (Original) The display according to claim 1 wherein:
said functional device comprises an optical imaging device.
4. (Original) The display device according to claim 3 wherein said optical imaging device includes an optical system configured to project an image onto a light sensitive media.
5. (Original) The display according to claim 2 wherein said switch platform comprises pressure sensitive switches mounted in proximity to respective edges of said display and configured so that touching at a corner operates a corresponding one of said switches and touching at a midpoint of one of said edges operates a corresponding pair of said switches.
6. (Original) The display according to claim 1 wherein said display is mounted on said switch platform, said switch platform, which, in turn, is mounted on an enclosure, wherein said enclosure encompasses at least a portion of said functional device, and said switch platform including pressure sensitive switches positioned to detect pressure applied proximate respective corners of said display.

7. (Original) The display according to claim 6 further comprising a pressure sensitive switch positioned to detect pressure applied to a central portion of said display.

8. (Original) The display device according to claim 1 wherein said switch platform comprises a plurality of electrical switches mounted adjacent respective edges of said display and a frame mounted to said switches, said frame surrounding said display, said frame and switches configured to detect pressure applied proximate respective corners of said flat panel display.

9. (Original) The device according to claim 8 further comprising a pressure sensitive switch positioned to detect pressure applied to a central portion of said display.

10. (Original) The display according to claim 1 wherein said display is a rectangular shaped liquid crystal display device.

11. (Original) The display device according to claim 2 wherein said electronic control system is configured to cause said display to display a value of a control parameter and to detect an operation of said switch platform to change said value.

12. (Original) The display device according to claim 1 wherein said electronic control system is configured to allow a user to selectively position a cursor or said display.

13. (Original) A camera comprising:
an optical system configured to project an image onto an imaging platform;
a controller configured to control an operation of said optical system;
a display operable to provide a visual display of parameter values used in conjunction with said optical system; and
a switch platform configured to provide control signals to said controller for selecting said parameter values, said switch platform mounted to detect a touching about a periphery of said display and operational for providing a plurality of discrete output signals to said controller, each indicative of a portion of said periphery at which said touching is detected.

14. (Original) The camera according to claim 13 wherein said display is a flat panel display.

15. (Original) The camera according to claim 13 wherein said switch platform comprises a plurality of electrical switches mounted adjacent respective edges of said display and a frame mounted to said switches, said frame surrounding said display, said frame and switches configured to detect pressure applied proximate respective edges of said flat panel display.

16. (Original) The camera according to claim 15 further comprising a pressure sensitive switch positioned to detect pressure applied to a central portion of said flat panel display.

17. (Original) The camera according to claim 13 wherein said display is configured to sequentially display a plurality of parameters in response to respective activations of left and right portions of said switch platform, increase and decrease a value associated with a displayed one of said parameters in response to activations of top and bottom portions of said switch platform, and select a displayed one of said values in response to a touching of a central portion of said flat panel display.

18. – 20. (Canceled)